

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of:

Application Serial no. 85095429

Published in the *Official Gazette*

January 11<sup>th</sup>, 2011

PSYBAR LLC )

Opposer )

Opposition No. 91198483

v. )

David Mahony, Ph.D., ABPP )

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicant, David Mahony, Ph.D., ABPP, for his answer to the Notice of Opposition filed by Psybar, LLC against application for registration of Psybar's trademark Psybar, Serial no. 1998368 filed 10/10/1995 and published in the Official Gazette of 06/11/1996, pleads and avers as follows:

1. Answering paragraph 1 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 1 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.



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2. Answering paragraph 2 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 2 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.
3. Answering paragraph 3 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 3 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.
4. Answering paragraph 4 of the Notice of Opposition, Applicant affirms allegation.
5. Answering paragraph 5 of the Notice of Opposition, Applicant denies each and every allegation contained therein.

FURTHERMORE, Applicant sets forth the following in support of its defense;

6. Applicant affirmatively alleges that the services under the Opposer's mark as described on the USPTO website (serial # 75003269, registration # 2000020) are IC Class 042; "providing scientific consultation to the legal community, namely providing expert witness testimony, voir dire and scientific jury selection advice, and litigation strategy services."
7. Applicant further affirmatively alleges that upon information and belief any trademark or service mark rights that the Opposer may have are narrowly

circumscribed to the goods or services indicated in the Opposer's registration (serial # 75003269, registration # 2000020).

8. Applicant further affirmatively alleges that the services under the Applicant's mark as described on the USPTO's website (serial #85095429) are IC Class044; "Personality testing for psychological purposes; Providing psychological profiles and psychological record analysis and assessments via a website that are designed to provide custom tailored outputs about recommended resources and treatments associated with a defined set of symptoms and concerns; Psychological assessment services; Psychological testing; Psychological testing services; Psychological tests."
9. Applicant further affirmatively alleges that the Applicant provides services in bariatric psychology including but not limited to the evaluation and treatment of bariatric surgery candidates and/or individuals with obesity.
10. Applicant further affirmatively alleges that Applicant's mark is unique and distinctive. Applicant's mark, PsyBari, specifically describes the Applicant's services, *psychological evaluations for bariatric surgery candidates*, and in no manner implies or suggests the Opponent's services described in the Opposer's registration (serial # 75003269, registration # 2000020).
11. Applicant further affirmatively alleges that the Opposer based upon information and belief is not involved in any manner in the field of bariatric psychology and/or obesity and has no future plans for becoming involved in the field of bariatric psychology and/or obesity including, but not limited to, research,

psychological evaluations and/or treatment for bariatric surgery candidates and/or individuals with obesity.

12. Applicant further affirmatively alleges that the services rendered by the Applicant and based upon information and belief, the services rendered by the Opponent, are unique and distinct, with no overlapping characteristics.
13. Applicant further affirmatively alleges that Applicant's mark and Opposer's mark are different in spelling.
14. Applicant further affirmatively alleges that any similarity, if at all, between Applicant's mark and the pleaded marks of the Opposer in the "Psy" portion of the marks, upon information and belief has been used and is registered by numerous third parties in the psychological, psychiatric and mental health fields. As a result, Opposer cannot base any similarity between its pleaded marks and the mark of Applicant on the "Psy" portion.
15. Applicant further affirmatively alleges that Applicant's mark and Opposer's mark are different in connotation.
16. Applicant further affirmatively alleges that upon information and belief the "Bari" portion of Applicant's mark has been used and is registered by numerous third parties involved in the field of bariatrics. Therefore, the "Bari" portion of the Applicant's marks connotes the field of bariatrics and the immediate idea of the services rendered by the Applicant is understood without any exercise of imagination, thought, or perception on the part of the user/purchaser.

17. Applicant further affirmatively alleges that Applicant's mark does not falsely suggest a connection with Opposer's mark.
18. Applicant further affirmatively alleges that Applicant's mark and upon information and belief, Opposer's mark, have distinct and separate users/purchasers.
19. Applicant further affirmatively alleges based upon information and belief, that users of the Applicant's services have no current or future interest in the Opposer's services.
20. Applicant further affirmatively alleges based upon information and belief that the purchasers of the Opposer's services have no current or future interest in the Applicant's services in bariatric psychology which includes but is not limited to research, evaluation and treatment of bariatric surgery candidates and/or obese individuals.
21. Applicant further affirmatively alleges that Applicant has no future plans for engaging in services other than bariatric psychology including, but not limited to, research, evaluation and/or treatment of bariatric surgery candidates and/or individuals with obesity.
22. Applicant further affirmatively alleges that the Applicant's and Opposer's channels of trade are different.

23. Applicant further affirmatively alleges that the Applicant's services are delivered in a unique fashion via an Internet, i.e., web based scoring system.
24. Applicant further affirmatively alleges that based upon information and belief the Opposer's services are not delivered via the Internet. Based upon information and belief the Opposer's services are delivered in the offices of mental health practioners throughout the United States.
25. Applicant further affirmatively alleges that upon information and belief, users/purchasers of Applicant's services and Opposer's services are sophisticated purchasers.
26. Applicant further affirmatively alleges that upon information and belief, users/purchasers of Applicant's services and Opposer's services are not impulsive purchasers.
27. Applicant further affirmatively alleges that upon information and belief, users/purchasers of Applicant's services and Opposer's services establish "accounts" with both services and therefore have long term commercial and/or scientific relationships with the Applicant and/or Opposer. Communication required to establish a long term relationships excludes the possibility of confusion or mistake between the Applicant's and Opposer's products or deception by the Applicant.

28. Applicant further affirmatively alleges that given the differences in the Applicant's and Opponent's services, users/purchasers, and channels of trade between the Applicant and the Opposer, there can be no confusion or mistake on the user/purchaser's part as to source of the respective services.
29. Applicant further affirmatively alleges that upon information and belief, Opposer's mark is not famous.
30. Applicant further affirmatively alleges that Opposer did not complain of any actual case of confusion, mistake or deception for past 9 years that Applicant's mark has been in use and is consequently barred by laches and estoppel from opposing Applicant's application.
31. Applicant further affirmatively alleges that Opposer did not complain of any actual case of confusion, mistake or deception for the past 9 years that Applicant's webpage, PsyBari.com, has been in use and is consequently barred by laches and estoppel from opposing Applicant's application.
32. Applicant further affirmatively alleges that Opposer did not complain of any actual case of confusion, mistake or deception for the past 5 years that Applicant's mark has been published in scientific journals and is consequently barred by laches and estoppel from opposing Applicant's application.
33. Applicant further affirmatively alleges that Opposer did not complain of any actual case of confusion, mistake or deception for the past 6 years that Applicant's mark has been published and presented at professional/scientific

conferences and is consequently barred by laches and estoppel from opposing Applicant's application.

34. Applicant further affirmatively alleges that as a result of its continuous substantial usage of its mark since adoption in 1/25/2002 this mark is a valuable asset of Applicant and carries considerable goodwill and scientific acceptance of its services rendered under the mark. Such goodwill and scientific usage has made the mark distinctive to the Applicant.
35. Applicant further affirmatively alleges that in email communication on June 16<sup>th</sup> of 2010 from the Opposer to the Applicant, Opposer did not request that the Applicant discontinue use of the Applicant's mark. Opposer requested that Applicant pay Opposer a "licensing fee" for the use of the mark. This affirms Opposer's acquiescence that the Applicant's mark and Opposer's mark are not confusingly similar, will not be mistaken for each other, and that the Applicant's mark is in no way deceptive.
36. Applicant further affirmatively alleges that in email communication on June 16<sup>th</sup> of 2010 from the Opposer to the Applicant, Opposer did not request that the Applicant discontinue use of the Applicant's mark. Opposer requested that the Applicant pay the Opposer's attorney's fees for "licensing" the Applicant's mark to the Applicant. This affirms Opposer's acquiescence that the Applicant's mark and Opposer's mark are not confusingly similar, will not be mistaken for each other, and that the Applicant's mark is in no way deceptive.

WHEREFORE, Applicant requests that the notice of opposition be dismissed.



Respectfully submitted,

PsyBari

By: David Mahony PhD

David Mahony, Ph.D., ABPP

PsyBari

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Date: March 8, 2011